PTO/SB/21 (08-03)

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6 5 3C/2	Application Number	10/609,012
A THANCAUTTAL	Filing Date	
TRANSMITTAL		June 27, 2003
FORM	First Named Inventor	Theo T. Nikiforov
to be used for all correspondence after initial f		1637
PATENT & TRADE	Examiner Name	Jeffrey Siew
	Attorney Docket Number	100/07933
Total Number of Pages in This Submission		
	ENCLOSURES (Check all that	t apply)
Fee Transmittal Form Fee Attached Amendment/Reply After Final Affidavits/declaration(s) Extension of Time Request Express Abandonment Request Information Disclosure Statement Certified Copy of Priority Document(s) Response to Missing Parts/ Incomplete Application Response to Missing Parts under 37 CFR 1.52 or 1.53	Drawing(s) Licensing-related Papers Petition Petition to Convert to a Provisional Application Power of Attorney, Revocation Change of Correspondence Addre Terminal Disclaimer Request for Refund CD, Number of CD(s) Remarks Please charge Deposit Account No. 03-0 or during pendency of this application	After Allowance communication to Technology Center (TC) Appeal Communication to Board of Appeals and Interferences Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) Proprietary Information Status Letter Other Enclosure(s) (please Identify below): PTO Form 1449 (2 pages) 19 references
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	TURE OF APPLICANT, ATTORN	EI, OR AGENI
Firm Andrew L. Filler, Reg. No.	44,107	
Individual name		
Signature And Walla	<u> </u>	V
Date 10-8-03 U		
CI	RTIFICATE OF TRANSMISSION	MMAILING
I hereby certify that this correspondence is b	eing facsimile transmitted to the USPTO or	r deposited with the United States Postal Service with tents, P.O. Box 1450, Alexandria, VA 22313-1450 on
Typed or printed name Michelle Chan		
Signature Muche	lle Chan	Date Oct 8, 2003

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



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gned: Michelle Chan

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No.

: 10/609,012

Confirmation No.:

8342

Applicant

Theo T. Nikiforov June 27, 2003

TC/A.U.

Filed

1637

Examiner Docket No.

Jeffrey Siew 100/07933

Customer No.

021569

Title :

Assay Methods and Systems

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Sir:

The references cited on the attached form PTO-1449 are being called to the attention of the Examiner. A copy of each reference is enclosed.

With this Supplemental Information Disclosure Statement, Applicant would like to bring to the attention of the Examiner the existence of pending patent litigation involving U.S. Patent Nos. 6,287,774 and 6,472,141, which were granted on applicant's earlier related U.S. Patent Application Nos. 09/316,447 and 09/569,193 filed May 21, 1999 and May 11, 2000, respectively. Applicant is calling the existence of this litigation (Caliper Technologies Corp. ("Caliper") v. Molecular Devices Corporation ("MDC"), Civil Case No.: C-02-1837 (CRB) (N.D. California, April 17, 2002)) to the Examiner's attention in accordance with Section 2001.06(c) of the Manual of Patent Examining Procedure.

In connection with that litigation, on January 28, 2003, Caliper filed a Motion for Preliminary Injunction which asks the Court to enjoin further sales of MDC's infringing "IMAP" products. On April 1, 2003, MDC filed a response Opposition memorandum, denying infringement and arguing that the patents are invalid as anticipated, and unenforceable for inequitable conduct, due to Applicant's failure to disclose a publication by Seethala et al. entitled

"A Homogenous Fluorescence Polarization Assay for Src-Family Tyrosine Kinases," *Analytical Biochemistry*, **253**, 210-218 (1997), which reference has been previously submitted to the Examiner in related co-pending patent application Serial No. 10/397,887 and also is being submitted herewith. Caliper filed a Reply memorandum and supporting declarations on April 11, 2003. The Court held a claim construction hearing on June 30, 2003. The Court issued its Claim Construction Order in the pending litigation on September 3, 2003. Applicant is submitting herewith MDC's redacted version of its Opposition to Caliper's Motion for Preliminary Injunction in that pending litigation, as well as supporting declarations (redacted by MDC) from Professor Andrew R. Barron, MDC's noninfringement and invalidity expert, and Richard Sportsman, MDC's Vice-President of Assay and Reagent Research and Development, as well as a copy of the Court's 9/03/03 Claim Construction Order.

It is respectfully requested that the cited information be expressly considered during the prosecution of this application, and the references be made of record therein and appear among the "references cited" on any patent to issue therefrom.

As provided for by 37 CFR §1.97(g) and (h), no inference should be made that the information and references cited are prior art merely because they are in this statement and no representation is made that a search has been conducted or that this statement encompasses all possible relevant information.

Applicants believe that no fee is required for submission of this statement, since it is being submitted within three months of the filing date or prior to the first Office Action. However, if a fee is required, the Commissioner is authorized to charge such fee to Deposit Account No. 03-0177. Please charge any additional fees or credit any overpayment to the above-noted deposit account.

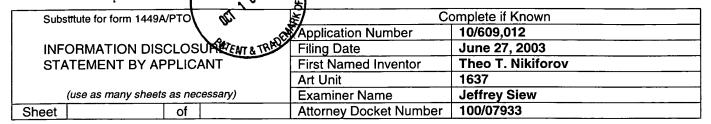
Respectfully submitted,

Andrew L. Filler Reg. No. 44,107

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U.S. PATENT DOCUMENTS					
Examiner	Cite	Document No. Number - Kind Code (if known)	Publication Date	Name of Patentee or Applicant	Pages, Columns, lines, Where Relevant Passages or Relevant
Initials	No.	5,804,395	09-08-1998	of Cited Document Schade et al.	Figures Appeal
				-	
	AB	6,287,774	09-11-2001	Nikiforov	
	AC	6,436,646	08-20-2002	Nikiforov	
	AD	6,472,141	10-29-2002	Nikiforov	

	FOREIGN PATENT DOCUMENTS					
Examiner Initials	Cite No.	Foreign Patent Document Country Code - Number - Kind Code (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	т
	AE	WO-9412665	06-09-1994	R-P Technologies		
	AF	WO-9964840	07-07-1999	Caliper		
	AG	WO-0023785	04-27-2000	LJL Biosystems		
	АН	EP- 781 853	07-02-1997	Eli Lilly Co.		
,	AI	EP- 786 666	07-30-1997	Hoffman La Roche		

		OTHER PRIOR ART - NON PATENT LITERATURE DOCUMENTS	
Examiner Initials	Cite No.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and-or country where published.	т
	AJ	COFFIN, J. et al., "Detection of Phosphopeptides by Fluorescence Polarization in the Presence of Cationic Polyamino Acids: Application to Kinase Assays" <u>Anal. Biochem.</u> (2000) 278:206-212	
	AK	ERICKSON, A.C. et al., "Metal (Fe3+) Affinity Chromatography: Differential Adsorption of Tau Phosphoproteins" <u>J. Neurosci. Methods</u> (1993) 46-245-249	
	AL	MUSCZYNSKA, G. et al., "Selective Asorption of Phosphoproteins on Gel-Immobilized Ferric Chelate" <u>Biochemistry</u> (1986) 25-6850-6853	
	AM	NIKIFOROV, THEO T. et al., "Detection of Hybrid Formation between Peptide Nucleic Acids and DNA by Fluorescence Polarization in the Presence of Polylysine" <u>Anal. Biochem.</u> (1999) 275:248-253	
	AN	PARK, Y-W. et al., "Homogeneous Proximity Tyrosine Kinase Assays: Scintillation Proximity Assay versus Homogeneous Time-Resolved Fluroescence" <u>Anal. Biochem.</u> (1999) 269:94-104	
	AO	SEETHALA, R. et al., "A Homogeneous, Fluorescence Polaration Assay for Src-Family Tyrosine Kinases" <u>Anal. Biochem.</u> (1997) 253:210-218	

Examiner	Date	
Signature	Considered	

^{*}EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Application Number Complete if Known Substitute for form 1449A/PT0 10/609,012 June 27, 2003 INFORMATION DISCLOS First Named Inventor Theo T. Nikiforov STATEMENT BY APPLICANT Art Unit 1637 (use as many sheets as necessary) **Examiner Name** Jeffr y Siew 100/07933 Sheet of Attorney Docket Number

A	SEETHALA, R. et al., "A Fluorescence Polarization Competition Immunoassay for Tyrosine Kinases" Anal. Biochem. (1998) 255:257-262
A	URIOS, P. et al., "Adaptation of Fluorescence Polarization Immunoassay to the Assay of Macromolecules" Anal. Biochem. (1990) 185:308-312
Al	Molecular Devices Corporation's redacted version of its Opposition to Caliper's Motion for Preliminary Injection in pending litigation US Civil Case No. C-02-1837 (CRB) and supporting declaration by Andrew R. Barron and Richard Sportsman
A	Claim Construction Order, US District Court, Northern District of California, Case No. C 02-01837, September 3, 2003

Examiner	Date	
Signature	Considered	

^{*}EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.